



Op 2754
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THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Gitis et al.
Assignee: Maxtor Corporation
Title: MAGNETIC HEAD SLIDER WITH RESISTANCE TO DEBRIS
ACCUMULATION
Serial No.: 09/491,284 Filed: January 26, 2000
Examiner: Ometz, D. Group Art Unit: 2754
Atty. Docket No.: 3123-149-1

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Washington, D.C. 20231

Technology Center 2600

PETITION FOR WITHDRAWAL OF RESTRICTION REQUIREMENT

Dear Sir:

This Petition is filed under 37 C.F.R. § 1.144 to request that the outstanding restriction requirement be withdrawn.

I. FACTS

The captioned-application was filed on January 26, 2000. The original application contained claims 1-9. A Preliminary Amendment which accompanied the original application amended various claims and added claims 10-69.

An Office Action was sent on September 11, 2000, which stated as follows:

This application contains claims directed to the following patentably distinct species of the claimed invention: Group I, Figures 3A-4B; Group II, Figures 5A-6C.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

A Response was filed on September 19, 2000, in which Applicant identified the claims and argued as follows:

<u>Group</u>	<u>Claims</u>
I	1-4 and 10-39
II	5-9 and 40-69

Applicant hereby provisionally elects Group I with traverse.

Applicant requests reconsideration of the restriction requirement. Independent claim 1 is directed to a recording head for reading and writing information with respect to a rotating disk medium. Independent claims 5, 10 and 40 are directed to a slider.

There must be a serious burden on the examiner if the restriction is required (M.P.E.P. § 803). Where the related inventions as claimed are shown to be distinct, the Examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following: (A) separate classification thereof; (B) a separate status in the art when they are classifiable together; or (C) a different field of search (M.P.E.P. § 808.02).

The Examiner has not even attempted to explain how examining Groups I and II would pose a serious burden (M.P.E.P. § 803), much less how these Groups would involve separate classification, separate status in the art, or a different field of search (M.P.E.P. § 808.02).

Accordingly, Applicant respectfully requests that the restriction requirement be withdrawn.

An Office Action was sent on December 5, 2000, which stated as follows:

Applicant's election with traverse of Group I in Paper No. 7 is acknowledged. The traversal on the ground(s) that "There must be a serious burden on the examiner if the restriction is required" and that the examiner "must show by appropriate explanation one of the following: (A) separate classification thereof; (B) a separate status in the art when they are classifiable together; or (C) a different field of search." This is not found persuasive because the restriction requirement on 9/11/2000 was based upon species under a genus being independent from one another. Applicant's attention is directed to the last three lines of MPEP section 803 which refers to one to other sections of the MPEP relating to species-genus restriction practice. Specifically, MPEP section 803 refers one to MPEP section 808.01(a) which relates to species-type restrictions between independent inventions where it is set forth that "it is not necessary to show a separate status in the art or separate classification." Therefore, the Examiner has not erred in failing to provide reasons for separate status in the art or separate classification. Secondly, the undue burden upon the Examiner would be the unduly extensive and burdensome search performed in searching for two separate and distinct inventions.

II. ARGUMENT

The restriction requirement presented on September 11, 2000 alleged that the claims were directed to patentably distinct species. The restriction requirement did not alleged that these were independent inventions. M.P.E.P. § 808.01 is applicable to independent inventions, whereas M.P.E.P. § 808.02 is applicable to distinct inventions. Therefore, Applicant asserts that it is improper for the Examiner to sustain the restriction requirement based on M.P.E.P. § 808.01 when the original restriction requirement appeared to be based on M.P.E.P. § 808.02.

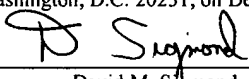
Furthermore, Applicant believes that the Examiner has not made a proper showing under M.P.E.P. § 808.01. In order for inventions to be independent, "they are not connected in design, operation or effect" (M.P.E.P. § 808.01). That is, "the case under consideration contains no disclosure of any commonality of operation, function or effect" (M.P.E.P. § 806.04(e)).

Applicant respectfully submits that the Group I and Group II claims do not meet this criteria. As mentioned above, independent claim 1 is directed to a recording head for reading and writing information with respect to a rotating disk medium, and independent claims 5, 10 and 40 are directed to a slider. Likewise, Figures 3A-4B (Group I) and Figures 5A-6C (Group II) are all directed to sliders designed to fly at a predetermined height above the surface of a rotating magnetic disk in a hard disk drive. This strikes Applicant as being connected in design, operation and effect.

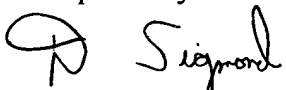
Applicant further submits that the Examiner has failed to explain in any meaningful sense why examining the Group I and Group II claims would constitute a serious burden. Applicant believes this mandatory provision was set forth in M.P.E.P. § 803 to avoid subjecting applicants to excessive costs and time delays associated with filing divisional applications when a single, perhaps more widely drawn search remained focused within a relatively narrow technical field. Although the more widely drawn search may be more inconvenient for the Examiner, that does not automatically constitute a serious burden on the Examiner. Applicant respectfully submits that this provision should not be treated as surplusage or dismissed by generic comments that searching for two separate and distinct inventions is inherently extensive and burdensome.

Therefore, Applicant respectfully requests that the restriction requirement be withdrawn.

Please charge any fee due under this Petition to Deposit Account No. 13-0016/149-1.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on December 15, 2000.	
	12, 15, 00
David M. Sigmond Attorney for Applicant	Date of Signature

Respectfully submitted,



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